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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,912	11/16/2001	Carl Alexander Kamb	VEN009/01/PCT	3497

7590

03/13/2003

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

09/990,912

**Applicant(s)**

KAMB ET AL.

**Examiner**

Jeffrey Fredman

**Art Unit**

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-92 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-54, 85, drawn to polypeptides, classified in class 530, subclass 350.
  - II. Claims 55-83, drawn to nucleic acids, classified in class 536, subclass 23.1.
  - III. Claim 84, drawn to methods of making polypeptides, classified in class 435, subclass 69.1.
  - IV. Claim 86, drawn to an antibody, classified in class 530, subclass 387.1.
  - V. Claims 87-89, drawn to methods of screening for cellular targets, classified in class 436, subclass 501.
  - VI. Claims 90-91, drawn to screening for therapeutics, classified in class 424, subclass 9.2.
  - VII. Claim 92, drawn to methods of treatment using polypeptides, classified in class 514, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions in Group I and in Groups II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the Group I product is drawn to proteins while Group II is drawn to nucleic

acids and Group IV to antibodies. The proteins, antibodies and nucleic acids represent structurally different molecules with different chemical characteristics, different methods of making and using and different functions and effects. These molecules are used in different methods to achieve unrelated purposes and operations. For example, a nucleic acid may be used in a hybridization assay to detect a bacteria, while an antibody may be used in a specific binding method to treat a disease and a protein may be used enzymatically to produce a desirable final product.

3. Inventions in Group I and in Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the protein can be made by expression in a cell, by enzymatic synthesis or by chemical synthetic mechanisms in vitro.

4. Inventions in Group I and in Groups V, VI and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the protein can be used in the cellular screening method of Group V, in the drug screening method of Group VI, in the therapeutic method of Group VII or in protein purification methods or in methods of antibody generation or in enzymatic assays.

5. Inventions in Group II and in Group III are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the nucleic acid may be used for the expression method of Group III or in nucleic acid diagnostic methods or in nucleic acid purification methods.

6. Inventions in Groups II, IV, V, VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the Group II and IV products are not used or made by the Group V, VI and VII methods and operates in different ways with different functions and different effects. Further, each of the methods is distinct from each other because each has different modes of operation and effects with the Group V method resulting in an identified target, the Group VI method resulting in a drug and the Group VII method resulting in a treated patient.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. In order to be perfectly clear, the following subgroups within the Groups are NOT species elections. These are independent and distinct because each polypeptide is structurally and functionally distinct from each other polypeptide.

There are three distinct polypeptides claimed in this specification, and the subgroups are:

Subgroup I – Cadherin V

Subgroup II – Cadherin VI

Subgroup III – Cadherin XI.

Applicant is required, after choosing one of the restriction groups above, to choose which of the Cadherin is to be examined.

9. A telephone call was made to Laura Handley on March 12, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

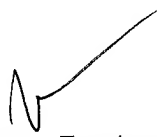
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is 703-308-6568. The examiner can normally be reached on 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jeffrey Fredman  
Primary Examiner  
Art Unit 1637

March 12, 2003